

No. 12,485

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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LEROY J. LEISHMAN,

*Defendant-Appellant,*

*vs.*

GENERAL MOTORS CORPORATION,

*Plaintiff-Appellee.*

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BRIEF FOR APPELLEE.

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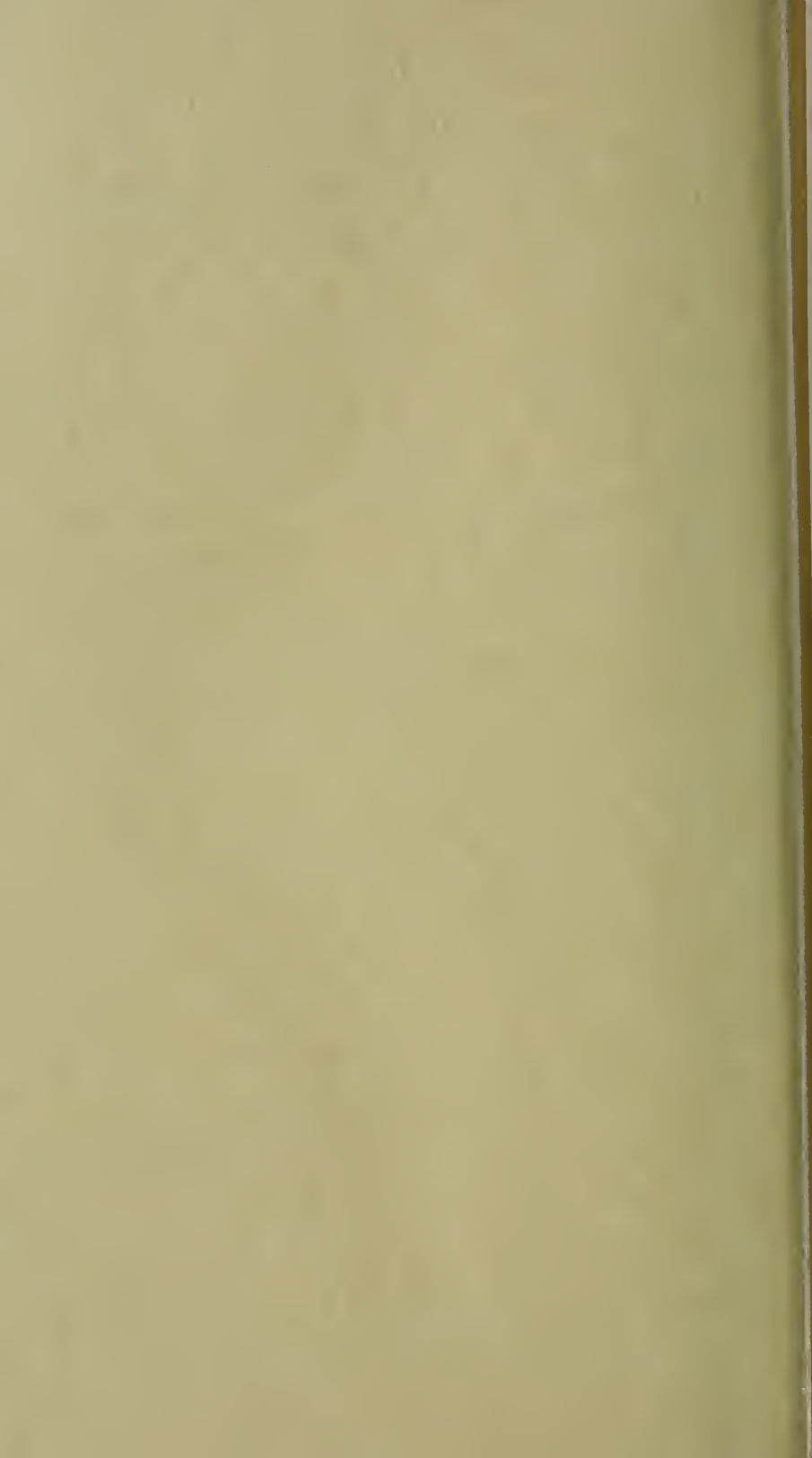
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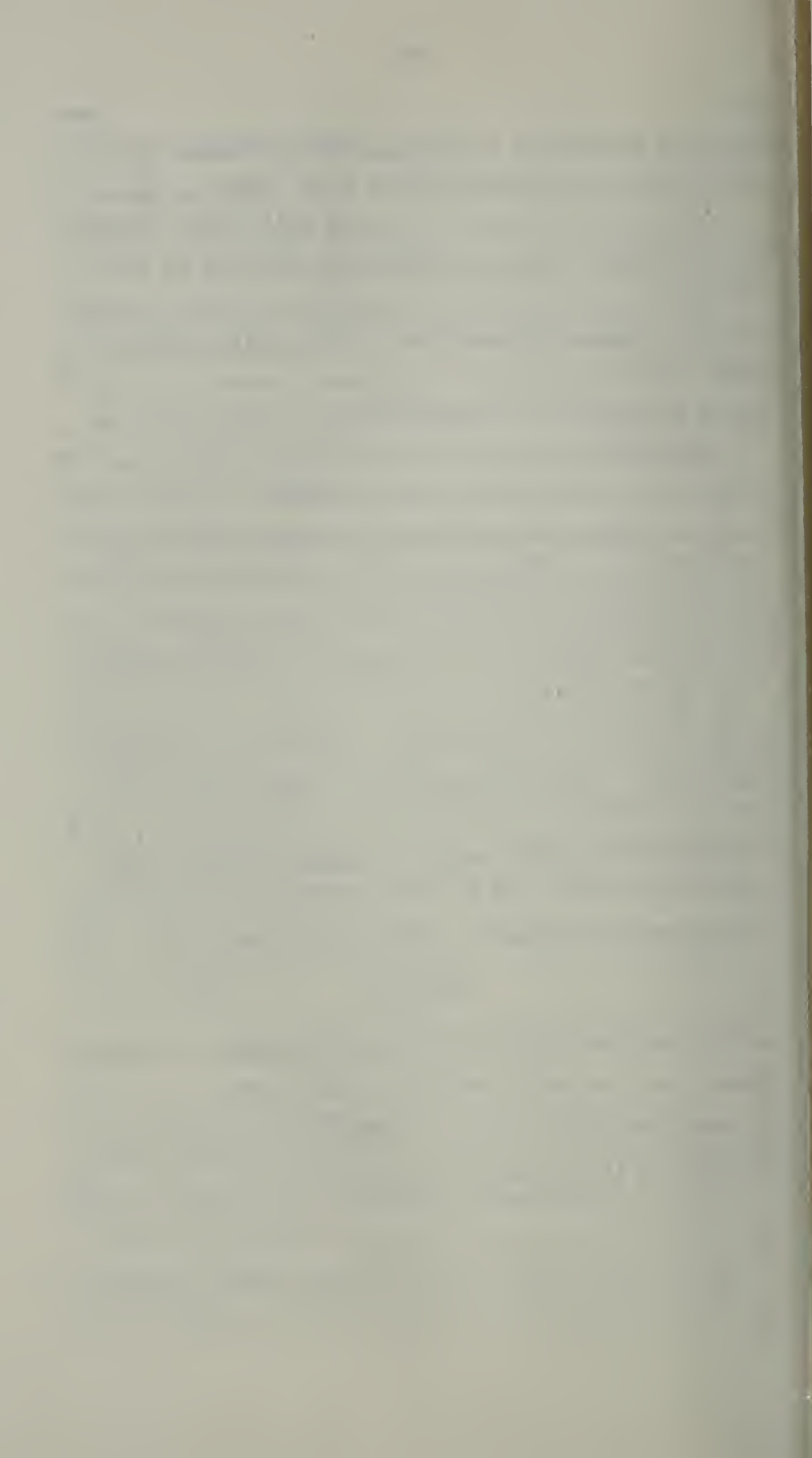
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## BRIEF FOR APPELLEE.

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This is an appeal from a declaratory judgment [R. 56-58] of the United States District Court for the Southern District of California, Central Division, holding claims 7 to 11, inclusive, of Reissue Patent No. 20,827 invalid.

Appellee on September 20, 1946, filed its complaint [R. 2-14] against appellant, a resident of the Southern District of California, alleging the existence of an actual controversy between the parties, alleging the invalidity of claims 7 to 11, inclusive, of Reissue Patent No. 20,827, and alleging that appellee did not infringe the patent. On February 20, 1947, appellant answered [R. 23], having previously filed on November 19, 1946, a counterclaim [R. 15-18] wherein validity and infringement were alleged. Appellee replied to the counterclaim [R. 18-22] on January 10, 1947.

After trial of the cause, the court below, on July 29, 1949, filed its memorandum of decision [R. 41-50], thereafter making its findings of fact and conclusions of law [R. 50-55] and rendering the judgment appealed from.

Following the judgment, appellant moved under Rule 52(b) of the Federal Rules of Civil Procedure to amend the findings, conclusions and judgment, and under Rule 59 for a new trial [R. 59-97]. On November 2, 1949, the court below denied these motions [R. 99], and appellant gave its notice of appeal December 1, 1949 [R. 99].

### Jurisdiction.

The jurisdiction of the District Court was based upon the Declaratory Judgment Statute, *Jud. Code, Sec. 274(d)*, 28 U. S. C. A., Sec. 400, and upon *Jud. Code, Sec. 24(7)*, 28 U. S. C. A., Sec. 41(7), as the actual controversy arose under the patent laws. The jurisdiction of this court is based upon *Section 1291* of new *Title 28, U. S. C. A.*

### Statement of the Case.

The extended statement of appellant is replete with argument and assumption which will be considered by appellee in subsequent portions of this brief. This court has considered the merits of the patent in suit twice before and in each instance has found the patent not infringed by devices patentwise precisely the same as the devices of appellee here in suit. *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722; *Leishman v. Radio Condenser Co., et al.*, 167 F. 2d 890. In each such case appellant petitioned to the Supreme Court for writ of certiorari, and in each case the petition was denied. 320 U. S. 816, 88 L. Ed. 493; 335 U. S. 891, 93 L. Ed. 429. Additionally,

appellant has litigated his patent in the Tenth Circuit against devices the same patentwise as the devices of appellee and there his patent was held invalid. *Richards & Conover Co. v. Leishman*, 172 F. 2d 365. There again appellant petitioned the Supreme Court for a writ of certiorari and such petition was denied. 336 U. S. 952, 93 L. Ed. 1107.

No outstanding decision exists in favor of the patent in suit either on the issue of validity or on that of infringement. In *Leishman v. Associated Wholesale Electric Co.*, 36 Fed. Supp. 804, Judge Harrison of the Southern District of California, Central Division, held the patent invalid for want of invention. This decision was modified in *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, to provide for a holding of non-infringement and, as so modified, affirmed, this Court stating at 727:

“Since the claims, if valid, are not infringed, the question of their validity need not be decided. The judgment declares that the claims ‘are invalid for want of invention.’ In the view we take, the declaration is unnecessary. As to its correctness or incorrectness, we express no opinion.”

In *Leishman v. Radio Condenser, et al.* (D. C., S. D. Cal., C. D., Civil Action No. 4395-B), Judge Beaumont, following the decision in the *Associated Case, supra*, held the patent not infringed on summary judgment and enjoined appellant from suing customers of plaintiffs therein on the patent. His decision was affirmed by this Court

in *Leishman v. Radio Condenser Co., et al.*, 167 F. 2d 890, which expressly reaffirmed its decision in the earlier *Associated Case*, stating at 892:

“Leishman contends that the California court erred in following our decision in the *Associated* case. There is no merit in this contention. Our decision has not been reversed or overruled. The California court was not at liberty to overrule it. We could overrule it if we thought it was wrong, but, after reconsidering it, we think it was right and now reaffirm it.”

This Court also modified the injunction by expanding its scope, and the injunction still stands at this date.

In *Leishman v. Richards & Conover Co.* (D. C., W. D. Okla., No. 2155), the District Court held the patent valid and infringed, but this decision was reversed in *Richards & Conover Co. v. Leishman*, 172 F. 2d 365, wherein the Court of Appeals for the Tenth Circuit held the patent invalid for want of invention. On rehearing, the same court reaffirmed its earlier decision.

In the instant case in the court below, Judge McCormick made no findings of fact, conclusions of law, or judgment respecting infringement but held the patent invalid as anticipated by the prior art and as lacking invention. In so doing, he followed the practice approved in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U. S. 327, 89 L. Ed. 1644, which decision came down subsequent to the decision of this Court in the *Associated Case*. Judge McCormick, in reaching his decision that the patent in suit is invalid, considered the *Richards & Conover Co. Case* in the Tenth Circuit as persuasive but not controlling, and agreed with Judge Harrison's original decision in the *Associated Case*.

In spite of the complicated litigious history of the patent in suit, the issue on this appeal is not complicated. Appellant's sole contention is that he was the first to conceive axis alignment or coaxiality in a radio tuner, and that his reissue patent entitles him to prevent the alignment of axes in radio tuners by others. Judge McCormick below determined as a matter of fact that coaxiality in a radio tuner does not constitute invention. The Court of Appeals for the Tenth Circuit likewise so held. Judge Harrison in the *Associated Case* reached the same conclusion. Additionally, this Court has twice held that, if valid, appellant's patent could only cover radio tuners including levers and could not cover plunger-type radio tuners such as those of appellee. Thus, in order that appellant prevail on this appeal, wherein he requests that this Court hold the patent both valid and infringed, this Court must reverse Judge McCormick, disagree with the Court of Appeals for the Tenth Circuit, disagree with Judge Harrison, and overrule two prior decisions of its own.

The title of the patent in suit [Deft. Ex. A, R. 799] is "Means and Method for Turning Rotatable Objects to Predetermined Positions." The patent states that the purpose of the invention is to provide a simple apparatus "for turning dials, shafts, and the like to the particular settings." The patent points out that the application of this invention to radio and television makes it possible automatically to tune in a radio broadcasting station and an associated television broadcasting station.

A radio receiver is customarily provided with a means (usually a variable condenser or gang of variable condensers) which is rotated to tune the radio receiver to a particular broadcasting station to be received. Presum-



ably, a television receiver would have a similar tuning means which upon rotation would tune a television receiver to a television broadcasting station. The reissue patent in suit shows a mechanical device which was intended by the patentee simultaneously to tune both a radio receiver and a television receiver in response to the movement of a single lever. The reissue patent is not concerned with the electrical characteristics of a radio or of a television apparatus, but rather is solely concerned with a mechanical device for automatically turning, in response to the operation of a lever, shafts, and thus the tuning controls of a radio and television apparatus to the particular positions necessary to tune in the predetermined radio broadcasting station and its associated television broadcasting station. On the other hand, the devices complained of herein are radio receivers only and have no associated television apparatus.

The mechanism of the Leishman reissue patent, which has, of course, been considered by this Court before, may be readily understood from Figure 2 of the drawings of the patent in suit. It will be seen that the mechanism of the patent includes a lever F pivoted at Q. The lever F has a projection to which is pivoted a cam or tappet 61. A rocker 48 is mounted upon a shaft S which is intended to be connected to the tuning means of a radio receiver. Similarly, pivoted to the lever F is a second cam or tappet 62, and another rocker 54 is mounted upon a shaft 25 distinct from the shaft S, which second shaft is intended to be connected with the tuning means of a television receiving apparatus.

The angular position of the cam or tappet 61 on the lever F and also the angular position of the cam or tappet

62 on lever F may be fixed by a friction lock actuated by a second lever 66 pivoted on the lever F and held by a set screw 71. The spring 73 normally holds the lever assembly up and out of the way.

With this apparatus, after the tappets 61 and 62 have been locked to desired positions on the lever F, whenever the lever F is pressed downwardly, as by the operator's finger on the top 72 of the set screw 71, the tappets will contact the rockers 48 and 54 and simultaneously rotate them. If the tappets have been properly set, this rotation of the rockers 48 and 54 is supposed to move, respectively, the shafts S and 25 and hence the tuning means of the radio receiver and television receiver to the correct positions for bringing in the station.

Thus, the device of the patent in suit consists of a *lever* adjustably mounting two *tappets* which are movable by the lever into contact with two *rockers* attached to shafts to be positioned by a movement of the lever.

The two tuners which are charged to be infringements of the reissue patent in suit are Plaintiff's Exhibits 6 and 7 [R. 109]. Neither of these tuners is at all concerned with tuning in a television station and therefore neither of these tuners includes any means for such tuning.

Referring to Plaintiff's Exhibit 6, it will be seen that the device consists of a push button engaging a plunger which carries a tappet adjustably movable in an arcuate guideway. A rotatable rocker is mounted upon a shaft which is connected with the tuning means of a radio receiver. The position of the tappet with respect to the plunger may be fixed by a locking clamp actuatable by a screw, and a spring is provided to hold the plunger and tappet normally out of the way.



In the Exhibit 6 tuner, after the tappet has been locked in a certain position on the plunger, whenever the plunger is pressed inwardly, as by the operator's finger on the push button, the said tappet will contact the rocker and rotate the rocker and shaft to a predetermined position to so actuate the radio tuning means that the selected radio station will be brought in. Since the tuner is not concerned with a television receiver, no second tappet is provided and no second rocker is provided.

Plaintiff's Exhibit 7 is similar to the aforescribed tuner, having a push button, a plunger, a tappet, and a rocker mounted upon a shaft, the plunger assembly being held out of the way by a spring. However, the tappet is not mounted to adjustably slide in a guideway, but rather is pivotally connected to the plunger to adjustably move about a pivot and to be clamped into proper position by a clamp. This tuner, also not being concerned with television tuning, provides no second tappet or second rocker.

In the patent in suit, Defendant's Exhibit A, Figure 2, the rocker shafts S and 25 are aligned with the pivot points of the tappets 61 and 62 when the respective tappets and rockers are in fully engaged positions. In appellee's tuner Exhibit 6, the center of rotation of the tappet when said tappet is in full engagement with the rocker is aligned with the shaft, and similarly in the tuner Exhibit 7, the pivot point of the tappet and the shaft of the rocker are aligned in fully engaged position. Such axial alignment admittedly has nothing to do with the actual shaft positioning, which is determined by the

angular disposition of the tappet when it engages the rocker. However, in normal every day operation it may occasionally be desired to change the angular disposition of a particular tappet so that on depression of its push button a different station will be tuned in than previously. For example, one of the push buttons on a radio set has been bringing in KPO. It is desired that that push button bring in a different station. The tappet for that particular push button must be reset angularly to accomplish this, and it is with this operation that appellant claims the aforesaid alignment is important. He asserts that absent such alignment, there is a tendency for the tappet to creep, or detune during such resetting. Appellant contends that such aligned condition, which he defines as coaxiality, constitutes a patentable invention properly secured to him in his patent, and that this invention has been appropriated by appellee in the aforescribed alignments in the tuners, Exhibits 6 and 7.

As stated before, Judge McCormick below did not rule on infringement, holding as a matter of fact that the coaxiality claimed by appellant was anticipated by Marschalk Patent No. 2,072,897 and Schaefer Patent No. 1,906,106, and by Cunningham Patent No. 1,930,192, and that axis alignment or coaxiality in radio tuners did not constitute invention [Findings of Fact Nos. 8 and 15, Conclusion of Law No. 3; R. 52-54]. In so holding, he agreed with the Court of Appeals for the Tenth Circuit and with Judge Harrison of the District Court for the Southern District of California, Central Division.

## Summary of Argument.

I. Judge McCormick's findings of anticipation and non-invention are findings of fact and should not be disturbed unless unsupported by substantial evidence and clearly erroneous.

II. Substantial evidence exists in the record proving that the patent in suit is anticipated by Marschalk Patent No. 2,072,897 and by Schaefer Patent No. 1,906,106, and by Cunningham Patent No. 1,930,192.

- (a) The general combination of a lever adjustably mounting a tappet which is movable by the lever into contact with a rocker attached to a shaft to be positioned is disclosed in the prior Marschalk patent.
- (b) Axis alignment or coaxiality in a radio tuner is disclosed in the prior Schaefer patent.
- (c) The lever-tappet-rocker combination of the patent in suit, wherein the axes of tappet and rocker are aligned or coaxial, is disclosed in the prior Cunningham patent.

III. Substantial evidence supports the finding of the court below that the Leishman patent is lacking in invention, which finding agrees with the prior decisions and should not be disturbed.

- (a) The evidence shows that there was no long-felt want for the alleged invention, no period of unsuccessful effort on the part of others to achieve the alleged invention, and no superseding by the invention of that which had gone before.

(b) The coaxiality of the patent in suit is the mere utilization of a common and well-known expedient for avoiding moment arms.

(c) As a matter of comity this Court should follow the decision of the Court of Appeals for the Tenth Circuit in *Richards & Conover Co. v. Leishman*, 172 F. 2d 365.

IV. The patent in suit is for a different invention than was the original patent from which it reissued and hence is invalid.

(a) Appellant's persistence in asserting for his patent a scope held invalid by this Court in *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, should result in a holding of invalidity thereof by this Court.

(b) The coaxiality now claimed by appellant to constitute the invention of his reissue patent is not the same invention his original patent intended to claim and secure.

V. Even should this Court hold the patent in suit valid, it should follow its prior decisions and hold the patent not infringed by appellee.

## ARGUMENT.

1. The Findings of the Lower Court That the Patent in Suit Is Anticipated and Is Lacking in Invention Are Findings of Fact and, as Such, Should Not Be Disturbed Unless Clearly Erroneous and Unsupported by Substantial Evidence.

The court below held the patent in suit invalid. Such holding was based upon the finding of fact that the patent is anticipated and is lacking in invention [Findings of Fact Nos. 8, 9 and 15, R. 50-54.] In this the court below agreed with the decision of the Court of Appeals for the Tenth Circuit in *Richards & Conover Co. v. Leishman*, 172 F. 2d 365, and agreed with the previous decision of Judge Harrison in *Leishman v. Associated Wholesale Electric Co.*, 36 Fed. Supp. 804. Yet appellant briefs his case as though this appeal were a *de novo* proceeding, and contents himself primarily with numerous references to evidence which in his opinion is indicative of invention. It is submitted that in this appellant misconceives the nature of the appellate function of this Court.

At least since the Patent Act of 1836 it has been recognized by the Supreme Court that the presence or absence of novelty and invention in a particular case presents a question of fact. *Turrill v. M. S. & N. I. R. R. Co.* (1864), 1 Wall. 491, 68 U. S. 668; *Keyes v. Grant* (1886), 118 U. S. 25, 30 L. Ed. 54; *Royer v. Schultz Belting Co.* (1890), 135 U. S. 319, 34 L. Ed. 214; *Thomson Spot Welder Co. v. Ford Motor Co.* (1924), 265 U. S. 445, 68 L. Ed. 1098. This Court has uniformly followed this fundamental rule. *McRoskey v. Braun Mattress Co.* (9 Cir., 1939), 107 F. 2d 143; *Page v. Meyers* (9 Cir., 1946), 155 F. 2d 57; *Refrigeration Engineering, Inc. v. York Corporation* (9 Cir., 1948),



168 F. 2d 896; *Faulkner v. Gibbs* (9 Cir., 1948), 170 F. 2d 34. As late as February 28, 1949, the Supreme Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 93 L. Ed. 672, expressly reaffirmed the rule, as immediately recognized by the Court of Appeals for the Seventh Circuit in *Hazeltine Research, Inc. v. Admiral Corp.* (7 Cir., 1950) ..... F. 2d ....., 86 USPQ 289.

Since, therefore, the question of novelty or anticipation and the question of invention are questions of fact, the treatment of findings thereon is set forth in Rule 52(a) of the Federal Rules of Civil Procedure, which provides that such findings shall be binding upon an appellate court unless clearly erroneous. This was expressly recognized in the *Graver Tank & Mfg. Co. Case, supra*, the Supreme Court there holding that the findings of the lower court on invention were findings of fact, were supported by substantial evidence, and were therefore not clearly erroneous. Similarly, this Court, where substantial evidence is present to support findings on the question of novelty and invention, has always sustained such findings. *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.* (9 Cir., 1945), 151 F. 2d 91; *Maulsby v. Conzevoy* (9 Cir., 1947), 161 F. 2d 165; *Cutter Laboratories, Inc. v. Lyophile-Cryochem Corporation, et al.* (9 Cir. 1949), 179 F. 2d 80.

It is therefore incumbent upon appellant to do more than merely urge that evidence exists in this case which might lead a trier of fact to the conclusion that novelty and invention are present in his patent. To induce this Court to overturn Judge McCormick's findings of fact, appellant must demonstrate that there exists no evidence in the record which might have led Judge McCormick to

his conclusion that the patent is anticipated and lacks invention. This, appellee submits, appellant has not even purported to do. Moreover, it will be shown hereinafter that not only substantial evidence but overwhelming evidence is present in the record in the instant case to show that appellant's patent lacks both novelty and invention.

**2. The Finding of the Court Below That the Leishman Patent Is Anticipated by Marschalk Patent No. 2,072,897 and by Schaefer Patent No. 1,906,106, and by Cunningham Patent No. 1,930,192, Is Supported by Substantial Evidence Proving Such Anticipation and Is Therefore Not Clearly Erroneous.**

Judge McCormick expressly found that every element, feature and mode of operation of the tuner of the Leishman patent are anticipated in the light of the teachings of the Marschalk Patent No. 2,072,897 and the Schaefer Patent No. 1,906,106 [Finding of Fact No. 8, R. 52]. He found that the coaxial characteristic of the patented tuner is anticipated by the said Schaefer patent, and that the function and mode of operation of the Schaefer patent is identical with that of the patented tuner [Finding of Fact No. 9, R. 52]. He further found that Cunningham Patent No. 1,930,192 is in the same art as is the patent in suit, that such patent will perform the same result in the same way as does the patent in suit, and that such patent anticipates the patent in suit [Findings of Fact Nos. 13, 14 and 15, R. 53, 54].

These findings are findings of fact and appellee submits that not only does substantial evidence exist in the record supporting the findings but that the evidence proves conclusively such anticipation.



- (a) The Marschalk Patent Discloses the Appellant's General Combination of a Lever Adjustably Mounting a Tappet Which Is Movable by the Lever Into Contact With a Rocker Attached to a Shaft to Be Positioned.

As hereinbefore explained, the patent in suit consists essentially in a lever adjustably mounting two tappets which are movable by the lever into contact with the rockers of two shafts to be positioned by a movement of the lever. Considering only the lever, the tappet and the rocker adapted to position the radio tuning shaft in appellant's device, which combination is the subject of appellant's reissue claims in suit, the evidence consisting of the Marschalk patent [Deft. Ex. E-1, R. 822] proves the general combination to be old.

The Marschalk patent taught a device for automatically tuning a radio receiver at selected intervals of time to different broadcasting stations. It disclosed the same combination of a pivoted lever adjustably mounting a tappet intended to be brought in contact with a rocker connected to a shaft of a variable condenser, as is disclosed in the reissue patent in suit. The levers of this patent are intended to be automatically operated by electric control means including solenoids, so that the radio receiver can be controlled automatically by the time controlled device. The mechanism for rotating the condenser shaft and thus tuning the receiver, however, is the same as that of the Leishman reissue patent in suit. It consists of a lever 37 adjustably mounting a tappet 44 which is movable by the lever into contact with a rocker 34 attached to the shaft to be positioned.

Appellant's principal argument with respect to the Marschalk patent, however, is that the axis of the tappet of Marschalk is not aligned with the axis of the rocker

of Marschalk, whereas such alignment, that is, coaxiality between the tappet axis and rocker axis, is present in his patent. As will be shown hereinafter, such alignment or concentricity for the purpose of balancing forces was not necessary in the particular Marschalk structure, is but a common mechanical expedient, and is not invention. Moreover, the evidence in this case proves that such alignment or coaxiality was old prior to appellant's alleged invention.

**(b) The Schaefer Patent Discloses Coaxiality in a Radio Tuner, the Function and Mode of Operation of Which Is Identical With That of the Patent in Suit.**

The Schaefer patent No. 1,906,106 [Pltf. Ex. 18, R. 789] was prior to the Marschalk patent and discloses a radio tuner comprising essentially the same elements as shown in the Marschalk patent and in the patent in suit, having, however, a rack and pinion multiplier instead of a rocker. The Schaefer patent was incorporated in radio tuners manufactured by Zenith [Deft. Ex. H, R. 327] during the late 1920's. It was later incorporated into radio tuners manufactured by appellee [Pltf. Ex. 3, R. 339] and sold during 1939 and 1940, being provided, however, with plungers instead of levers [R. 147, 336, 337 and 363].

As shown by Figure 4 of the drawings in the Schaefer patent, the mechanism of the Schaefer patent includes the lever 51 pivoted at 21. A cam or tappet 56 is pivoted to an extension of the lever 51. There is provided a second lever 61 pivoted to the lever 51, which second lever is for the purpose of locking the tappet in a selected position, and this second lever is held in position by a set screw 65. A spring 49 normally holds the lever assembly in an upper position. The shaft of the radio set

to be tuned is connected with the shaft 9 which is provided with a pinion 24 meshing with two racks providing the spaced arms 32 and 34.

In the operation of the mechanism of the Schaefer patent, when the operator presses the lever 61 downwardly, as by the pressure of a finger on the set screw 65, the tappet 56 engages the two spaced arms 32 and 34, turning the rack and pinion to a predetermined position thereby to position the shaft 9 to the particular setting necessary to bring in a predetermined radio broadcasting station.

It will be noted that in the Schaefer device the arms numbered 32 and 34 of the rack and pinion move symmetrically about a line or axis. This axis or symmetrical point is located midway between the arms 32 and 34, and horizontally at a point aligned with the arms 32 and 34 when the said arms are moved to a common level. Schaefer designed his apparatus so that the axis 55 of his tappet 56 would coincide with this axis or point of symmetry of the rack and pinion when the tappet 56 is brought into engagement with the arms 32 and 34, thus incorporating into his tuner coaxiality.

With respect to the Schaefer patent appellant contends, first, that in providing coaxiality in a tuner having a rocker rather than a rack and pinion system, appellant was able to provide a device having fewer parts than did Schaefer and that such deletion of parts is evidence of invention. Secondly, appellant contends that the Schaefer patent does not in fact disclose coaxiality.

As to appellant's first contention two things are immediately apparent. Judge McCormick, faced with the same argument below, recognized that it was Marschalk, not appellant, who in fact was responsible for any deletion

of parts claimed by appellant. The Schaefer tuner includes a lever, a tappet pivotally mounted thereon, and a rack and pinion system engaged by the said tappet. When Marschalk substituted for the rack and pinion of Schaefer the rocker of Marschalk, the deletion of parts of which appellant speaks was compelled, a rocker inherently including less parts than a rack and pinion system. Furthermore, appellant's contention that a deletion of parts may provide evidence of invention and his citation of authorities that under particular factual situations differing from the situation here such deletion of parts might constitute invention, provides no basis for upsetting Judge McCormick's finding of fact that the patent in suit is anticipated by the Marschalk and Schaefer patents. Such finding of fact is obviously supported by substantial evidence.

According to appellant's own argument, the only problem which his alleged invention of coaxiality solves is that of creeping during resetting in the Marschalk device; yet such problem had already been admittedly solved in Schaefer [R. 146], and the Zenith tuner was admitted by the patentee to pass the test for coaxiality which the patentee himself had prescribed for the industry [Pltf. Ex. 2, R. 698, R. 309 to 315]. That the Marschalk patent, which followed the Schaefer patent and Zenith tuner, did not include this coaxiality is easily understood in view of the fact that in the Marschalk patent the levers of the tuner were intended to be automatically operated by electric control means including solenoids for control by timing devices, whereas the Schaefer patent and Zenith tuner were for hand operated radio sets, subject, ordinarily, to more frequent resetting. Indeed, appellant was hard put at the trial below and before Judge Harrison to demonstrate a setting difficulty in



Marschalk. To do this appellant constructed a special model, Defendant's Exhibit E, which purported to resemble the Marschalk patent disclosure, but which was neither solenoid operated, as shown in the patent, nor included load factors, such as condensers and the like, shown in the patent. With this model appellant argued that at extreme tuning angles of the Marschalk rocker the fact that the pivot 46 was not aligned with the rocker axis 33 introduced a tendency for said rocket to slip from tuned position during setting [R. 130-134]. As to this demonstration, Judge Harrison in the *Associated Case*, *supra*, had this to say:

"The court has tried the instrument and the witness' testimony does not add anything to what the court has already ascertained from an examination and an effort on its part to work the mechanical device. I had no difficulty in setting the device at the extreme end, but it is true that a person has to use a greater amount of care. That was the result of the court's own experiment with the instrument." [R. 320-322.]

Appellant's second contention with respect to the Schaefer patent disclosure, whereby he states that such patent does not in fact disclose coaxiality, is erroneous. As stated hereinbefore, in the Schaefer patent an axis or symmetrical point is located midway between the arms 32 and 34 of the tuner and horizontally at a point aligned with said arms 32 and 34 when the arms are moved to a common level. The apparatus is so designed that the axis 55 of the tappet 56 coincides, that is, is aligned with this axis, when the tappet 56 is brought into engagement with said arms 32 and 34. In his direct examination, appellant testified that in order to achieve coaxiality, he specially shaped his tappet [R. 153, 154,

274, 275]. Schaefer specially shaped his tappet for the same reason, interspacing the arms 32 and 34 and rounding his tappet 56 so that it could pass between the arms 32 and 34 for the necessary distance to secure alignment between the axis of the tappet 56 and the axis or symmetrical point of the arms 32 and 34. As pointed out hereinbefore, by this relationship, Schaefer admittedly avoided any setting difficulty in his patented tuner, and the Zenith tuner was admitted to pass appellant's test for coaxiality.

Thus, the proofs in this case not only provide substantial evidence for Judge McCormick's findings that the Marschalk and Schaefer patents anticipate appellant's alleged invention, but show conclusively that it was Marschalk, rather than appellant, who substituted a rocker for the rack and pinion of the Schaefer structure to delete parts therefrom, and that it was Schaefer who originally conceived and disclosed the radio tuner coaxiality which appellant claims as his invention.

**(c) The Cunningham Patent Discloses Appellant's Lever-Tappet-Rocker Combination, Wherein the Axes of Tappet and Rocker Are Coaxial.**

Not only, as found by Judge McCormick, is the Leishman patent anticipated by Marschalk and Schaefer, but, as likewise found by Judge McCormick, the actual incorporation of coaxiality itself in a lever-tappet-rocker combination preceded appellant in the disclosure of the Cunningham patent No. 1,930,192 [Pltf. Ex. 10, R. 741]. The full teaching of this patent shows a gas register in which a shaft, set by an automatic shaft setting device, controls a marking pen and an electrical switch which by electrical means automatically controls the combustion in the device, the shaft also operating an electrical means

for transmitting the reading of the register to a distant station.

We are not here interested in the general purposes of the entire Cunningham structure, but are interested only in that feature of the device which consists in the means for automatically setting the shaft. Such means is shown in Figure 9 of the patent. Figure 9 discloses a lever 50 adjustably mounting a tappet 55, which is movable by the lever into contact with a rocker 57 attached to the shaft 58 to be positioned. As with the device of the patent in suit, and as with appellee's accused devices, the axis of the rocker 57 is coaxial with the axis of the tappet 55 when the tappet and rocker are in contact.

At the trial appellant introduced a model [Pltf. Ex. 11, R. 461]. Such model was constructed in accordance with said Figure 9, there being removed from the model, however, a hammer consisting of the shaft 44 and a bolt 43, and there being connected to the shaft 58 for illustrative purposes a radio tuning condenser [R. 452, 453]. Appellee's witness, Dr. Mackeown, described the model as having a lever, a tappet and a rocker, the said rocker carrying the shaft to be positioned [R. 452]. It will be seen that a second braking or locking lever (51 in Figure 9 of the patent) is pivoted to the tappet bearing lever, such lever duplicating the locking lever 66 of the patent in suit. Dr. Mackeown testified that this model, which contains all of the elements claimed by appellant in his patent, was capable of turning the shaft 58 and thus the attached condenser to any desired angle to bring in any radio station, just as the device of appellant. Dr. Mackeown testified:

"To set this device in the beginning the lever containing the tappet can be moved down to bring the tappet into engagement with the rocker. The con-



denser then can be positioned manually to any desired position. The brake then can be applied and then if that condenser is turned to any other position and the tappet is moved downwardly with the brake applied, the condenser will be brought back to that predetermined position.” [R. 453.]

Dr. Mackeown further testified that in Cunningham

“\* \* \* The axis of the rocker is coaxial with the axis of the tappet and there is a balance of all movements and there is no tendency at all for the lever to move as the rocker is rotated.” [R. 454.]

Again Dr. Mackeown referred to a letter to the trade written by appellant [Pltf. Ex. 2, R. 698] describing appellant’s test for coaxiality, applied that test to the model Exhibit 11, and showed that according to that test the Cunningham structure showed coaxiality [R. 454, 455].

Again, Dr. Mackeown testified that he saw the demonstration which appellant made in his direct testimony using the Marschalk model [Deft. Ex. E] for the purpose of showing its alleged setting difficulty, and Dr. Mackeown applied that precise demonstration to the model Plaintiff’s Exhibit 11. There was no tendency for the rocker to move or detune the condenser and Dr. Mackeown testified that the reason for this was because there was no unbalance of moments about the shaft bearing the rocker for the reason that the tappet and rocker in the model are coaxial [R. 455, 457].

It is therefore apparent that the model Plaintiff’s Exhibit 11, which represents Figure 9 of the Cunningham patent and which contains all the elements claimed by appellant for his invention in his reissue patent, in-

cluding rocker-tappet coaxiality, is capable of attaining the same result as appellant claims for his device and is capable of attaining that result in precisely the same way.

In view of this testimony, therefore, substantial evidence supports Judge McCormick's finding that the Cunningham patent anticipates the patent in suit. Appellant urges, however, that this finding is erroneous for the reason that the Cunningham structure is from an art not analogous to that of the patent in suit; that substantial alterations of the Cunningham disclosure were made in producing the model demonstrated at the trial; and that the problems in the Cunningham structure are different from the problems in the patented structure.

Appellant ignores the essence of his own claim to invention in urging that the Cunningham patent is from a non-analogous art. Admittedly, his sole claim to invention lies in incorporating coaxiality in a rocker-tappet system for shaft positioning, the general combination of lever, tappet and rocket being old as disclosed by the Marschalk patent. The fact that coaxiality in appellant's particular shaft positioning means may or may not find usefulness in radio tuners, and the fact that coaxiality in the same shaft positioning means disclosed in Cunningham may or may not find usefulness in a gas register, does not disqualify the Cunningham patent as a pertinent reference against the patent in suit. Appellant's patent is not limited to the radio tuner art. Its title is "Means and Method of Turning Rotatable Objects to Predetermined Positions." The appellant's patent states that it

"\* \* \* relates to improvements in automatic apparatus for turning rotatable objects about their axes to predetermined positions \* \* \*." (P. 1, col. 1, lines 3-6.)

Among the many purposes set forth in the patent, it is stated that

“The purposes of this invention are to provide simple apparatus for turning dials, shafts and the like to the particular settings required in using an instrument or machine for a definite task; to afford means whereby a plurality of such rotatable elements may be simultaneously turned each to a pre-selected position which may be different from that to which any other such element is being turned; to provide a simple manually operated control for accurately returning such rotatable elements to any desired previous position; to provide mechanism whereby a single manual operation will cause a plurality of rotatable members each to be turned to any one of a group of pre-selected positions; \* \* \*.” (P. 1, col. 1, lines 11-25.)

Thus appellant's patent is for a shaft positioning device and the same shaft positioning device is found in the Cunningham disclosure. Judge McCormick found that

“The Cunningham patent is in the same art of automatic shaft positioning devices as is the patent in suit.” [Finding of Fact No. 14, R. 53.]

The correctness of such finding is manifest. *In re Weingartner* (C. C. P. A., 1932), 58 F. 2d 442; *In re Kylstra* (C. C. P. A., 1937), 87 F. 2d 487; *In re Smyth* (C. C. P. A., 1941), 120 F. 2d 348; *Crown Cork & Seal Co. v. Sterling Cork & Seal Co.* (D. C., N. D., Ohio, W. D., 1913), 210 Fed. 26.

Appellant's second contention that the model, Plaintiff's Exhibit 11, represents substantial alterations from the Cunningham disclosure again ignores the substance of that which appellant purports to have contributed. The

only omissions in the model, Plaintiff's Exhibit 11, from the structure shown in Figure 9 of the Cunningham patent are the shaft 44 and bolt 43, which elements, as is obvious, have no function in the operations described by Dr. Mackeown and neither add to nor detract from the operation of the model in positioning a shaft to tune a condenser.

Lastly, appellant contends that no setting problem is present in the overall Cunningham structure which necessitates the use of coaxiality. From this he urges in effect that he has discovered a new advantage in coaxiality for radio tuners and has thereby made an invention. As will be shown hereinafter, appellant in fact discovered no new advantage of coaxiality, but merely is attempting to repatent its age-old function of balancing moment arms. However, even if appellant had discovered a new advantage in coaxiality, such would not be patentable.

In *General Electric Co. v. Jewel Incandescent Lamp Co., et al.*, 326 U. S. 242, 90 L. Ed. 43, the Supreme Court of the United States most recently had occasion to consider the problem of the anticipatory effect of prior art structures or articles which are removed from their settings and incorporated into different structures wherein utilization is made of the fact that the prior art structure will perform for a different purpose than originally intended. The case involved electric lamp bulbs having frosted interior surfaces. It had been found that such bulbs had, before the patentee, the disadvantage of a considerably reduced strength under that of the unfrosted bulbs. The patentee claimed as his invention the rounding of the sharp angular crevices of the frosting on the inside of the bulb which, it was proven, greatly increased the strength of the bulb.



Prior to the patentee's invention, it had been the practice to smooth off etchings for screens, outside frosted bulbs and the like for the purpose of improving light diffusion and transmission characteristics and for nothing else. The Supreme Court held the patent invalid as anticipated, quoting language from *Ansonia Brass & Copper Co. v. Electrical Supply Co.*, 144 U. S. 11, 36 L. Ed. 327, that

“\* \* \* ‘the application of an old process to a new and analogous purpose does not involve invention, even if the new result had not before been contemplated.’ ”

However, the patentee argued that here was not a case where the patentee merely observed the advantageous properties of an old article of manufacture. He urged that he had created a new article of manufacture, an inside-frosted bulb having an etched inner surface characterized by round rather than sharp crevices—an article that had never existed before. He further urged that before himself no one knew why inside frosted bulbs were weak nor knew how to remedy the weakness, and the court agreed that the prior art appeared to have made no such disclosure. However, the Supreme Court in its opinion said that whereas it was old to frost the inside of an electric bulb and whereas it was old to produce a smooth surface on etched glass, the smoothing of the inside surface of the inside-frosted bulb could not be invention even though no one prior to the patentee had smoothed frosted glass for the purpose of improving the strength in the glass. The Court stated at page 47:

“\* \* \* in the present case, the prior art discloses the method of making an article having the characteristics of the patented product, though all the

advantageous properties of the product had not been fully appreciated. *Lovell Mfg. Co. v. Cary*, 147 U. S. 623, 37 L. ed. 307, 13 S. Ct. 472. Pipkin found latent qualities in an old discovery and adapted it to a useful end. But that did not advance the frontiers of science in this narrow field so as to satisfy the exacting standards of our patent system. Where there has been use of an article or where the method of its manufacture is known, more than a new advantage of the product must be discovered in order to claim invention. See *De Forest Radio Co. v. General Electric Co.*, 283 U. S. 664, 682, 75 L. ed. 1339, 1347, 51 S. Ct. 563. It is not invention to perceive that the product which others had discovered had qualities they failed to detect. See *Corona Cord Tire Co. v. Dovan Chemical Corp.*, 276 U. S. 358, 369, 72 L. ed. 610, 614, 48 S. Ct. 380.”

In the instant case there is present, therefore, a patent expressly found by the court below to be of an analogous art. Such patent discloses exactly the combination claimed by appellant to be his invention. A model constructed in accordance with such disclosure is shown by the evidence to be capable of performing the precise operation of the patent in suit. Whether or not such operation was intended in the gas register environment of the Cunningham patent is immaterial, as is any added advantage appellant may purport to have perceived in using the structure for radio tuning. Judge McCormick’s finding of anticipation of the patent in suit by the Cunningham patent is manifestly supported by substantial evidence and is correct.

3. The Finding of the Court Below That the Leishman Patent Is Lacking in Invention Is Supported by Substantial Evidence, Is in Agreement With the Prior Decisions and Should Therefore Not Be Disturbed.

The major portion of appellant's brief respecting the validity of the patent in suit is devoted to the proposition that evidence exists in the record from which it might be inferred that invention is present. In arguing this proposition, appellant refers repeatedly to this Court's decision in *Pointer, d. b. a. Pointer-Williamette Co. v. Six Wheel Corporation* (9 Cir., 1949), 177 F. 2d 153, and urges that the evidence here provides those indicia of invention recognized there. Further, appellant attacks the decision of the Court of Appeals for the Tenth Circuit in *Richards & Conover Co. v. Leishman*, 172 F. 2d 365, and refers to affidavits of "leading authorities" which appellant contends demonstrate the incorrectness of that decision.

Judge McCormick below found as a fact that the patent in suit lacked invention [Finding of Fact No. 15, R. 54]. Appellee has shown hereinbefore that under fundamental principles of appellate review, a mere existence of evidence from which invention might be inferred is not competent to upset an express finding of fact of non-invention where substantial evidence supports such finding. Not only does substantial evidence support the finding of Judge McCormick, but such evidence conclusively proves that none of the indicia of invention recognized in the *Six Wheel Case, supra*, is present here, and that appellant's alleged contribution of coaxiality is but a simple mechanical expedient representing proper machine design. Furthermore, the Court of Appeals



for the Tenth Circuit was correct as was Judge Harrison in *Leishman v. Associated Wholesale Electric Co.*, 36 F. Supp. 804, and this Court under well-known principles of comity and uniformity of justice should follow that decision.

- (a) The Indicia of Invention Present in *Pointer, d. b. a. Pointer-Williamette Co. v. Six Wheel Corporation*, 177 F. 2d 153, Are Lacking in the Instant Case. Missing Here Is Any Long-Felt Want, Any Period of Unsuccessful Effort on the Part of Others, and Any Superseding Whatsoever by the Leishman Tuner of What Had Gone Before.

In the *Six Wheel Case*, this Court affirmed a holding below that invention in Knox Patent No. 1,926,727 was present. The Court first recognized that the findings of the trial court must be sustained unless clearly erroneous. Thereupon the court reviewed the evidence and found that it satisfied certain indicia of invention previously set forth by Judge Hand of the Second Circuit. These indicia of invention may be summarized and, so summarized, consist in the presence of a long-felt want for the particular invention, in a record of unsuccessful efforts by those preceding the inventor, and in the superseding by the inventor's product of what went before. The evidence in this case shows no long-felt want, no record of unsuccessful efforts by others preceding appellant, and no superseding by appellant's tuner of that which had gone before, indeed no use whatsoever of appellant's tuner.

In attempting to demonstrate a long-felt want for his alleged invention, appellant points to what purport to be earlier unsuccessful efforts in the field. He urges that these unsuccessful efforts are shown in Soffietti Patent

No. 2,388,581 [Deft. Ex. J, R. 838], Lane and Mackey application Serial No. 177,163 [Deft. Ex. K-1, R. 842], in the Marschalk and Schaefer patents, previously considered, and in the General Motors tuner [Pltf. Ex. 3, R. 339]. In evaluating the merits of appellant's contentions, these tuners should be considered in the light of appellant's own testimony as regards what his invention was.

After introducing and explaining various early tuners, clocks, and the like [R. 120-129], appellant described the Marschalk patent and introduced the model [Deft. Ex. E] allegedly representative thereof [R. 129-134]. The Marschalk patent, it will be recalled, discloses the general combination of lever, tappet and rocker shown in the patent in suit. The model, Defendant's Exhibit E, varies from the disclosure of the Marschalk patent in that the tuner of the patent was not intended for hand operation and had many load factors not present in the model. Appellant demonstrated from the said model the alleged setting difficulty present in Marschalk. This setting difficulty, appellant argued, posed the problem which he solved, and it is his solution [R. 153] which is alleged to constitute his invention. Appellant at the time of making his alleged invention and, indeed, until October, 1937, some three years subsequent to the filing in 1934 of his parent case [Deft. Ex. O, R. 843] from which his original patent No. 2,108,538 [Deft. Ex. P, R. 1001] reissued as the patent in suit, was divided, had not even seen the Marschalk patent [R. 288, 289]. Yet appellant testified:

"Q. (By Mr. Flam): I believe you demonstrated this Exhibit E to the court and explained how difficult it was to adjust the tappet in accordance with the position of the rocker,

Now, what is your solution, if any, to that difficulty?

A. Why, I figured that the difficulty could be overcome by making it—by making the axis of the tappet and the axis of the rocker coincide—that is to make the one axis coaxial with the axis of the other.

Q. Did you have any difficulty in doing that?

A. Why, I have a model that will show what was done. Of course it can be seen by the Marschalk device and by the rockers in the Soffietti and Lane & Mackey exhibits that the one tappet engages the surface of the rocker and, of course, two bodies can't occupy the same position at the same time, so in order to get the axis of one coaxial with the other I made an open rocker. I have an open rocker here and I prepared a little support to rest it on and that will show what I did.

I made an opening in the rocker in order to achieve this coaxiality and then I shaped the tappet so that when it is brought into an engagement with the rocker it has such a shape that the axis can sit down in the rocker. In other words I cut away the sides of the tappet to make it possible for the axis to set down inside of the axis of the rocker so that the two axes could become coaxial. And it will be noticed on this device that that kind of difficulty doesn't occur. You can press down there as hard as you want and you don't have any of that trouble occurring.

Now, here is a non-coaxial arrangement and you press that down and it immediately flips around the same as the Marschalk device, but this coaxial arrangement solved the difficulty. You see you have no difficulty at all." [R. 153-154.]

That then is appellant's claim to invention. It consists in the taking of the after-discovered Marschalk structure, modifying the same for hand operation, increasing its tendency to slip by decreasing the load on the tuner as hereinbefore pointed out, and in aligning the axis of the rocker with the axis of the tappet. Appellant's alleged invention does not even purport to be broad and basic to the problem of devising the first radio tuner. It is merely concerned with alleviation of an alleged and unproven minor setting difficulty in a structure which appellant did not even know of at the time he designed his tuner. Appellant originally thought himself to have been the discoverer of the basic lever-tappet-rocker combination. His incorporation of coaxiality in the tuner of the patent was a normal mechanical expedient and, as will be shown hereinafter, was not even claimed as an invention until appellant reissued his original patent.

Reduced to its proper setting, therefore, appellant's alleged invention, the problem which it purported to solve, and the solution which appellant purports to have come upon, bear no relation whatsoever to the alleged unsuccessful efforts of those preceding appellant. The problem which appellant purports to have solved is non-existent in the absence of a pivoted tappet, for it is in the positioning of such a tappet that the problem arises. The Soffietti patent evidences neither a long-felt want for appellant's alleged invention nor any unsuccessful effort in supplying that long-felt want. Such patent is totally immaterial in that it uses no pivoted tappet but rather two tappets varied by means of threads. The tuner of the Lane and Mackey application has a tappet that likewise is never free to turn and could therefore never exhibit the alleged difficulty present in Marschalk. The tuner of the Schaefer patent, as hereinbefore pointed



out, represented no unsuccessful approach to the problem allegedly solved by appellant, but rather anticipated appellant's patent by disclosing coaxiality. It was sold in the form of the Zenith tuner [Deft. Ex. H]. The General Motors tuner [Pltf. Ex. 3], as hereinbefore shown, likewise incorporated the Zenith structure, omitting, however, the levers thereof. Half a million of these tuners were sold in 1939 and 1940 [R. 336, 337]. Finally, of course, the Marschalk tuner was not designed for hand operation and frequent resetting. It was designed for solenoid operation in response to timed control devices.

Thus, none of the alleged evidence urged by appellant to constitute evidence of a long-felt want and of unsuccessful efforts of those preceding him sustains his position. The Soffietti and Lane and Mackey tuners bear no relation to his purported problem. In the Schaefer and General Motors tuners, the purported problem was already solved. In Marschalk, the problem could only exist by synthesizing the artificial structure, Defendant's Exhibit E.

The argument of appellant might be taken to mean, however, that he conceives himself to be the man responsible for the only practicable automatic radio tuner. This again is erroneous in view of the existence of the Zenith tuner which came upon the market and was sold for two years during 1929 and 1930, which was patented as the Schaefer patent, and which later reappeared in the form of a General Motors push button automatic automobile radio tuner of which approximately five hundred thousand were sold.

Moreover, as testified to by appellant's witness Schwarz, there was the Marvin type tuner of patent No. 1,707,754 [Ex. A to Defendant's Motion for Summary Judgment,



R. 108]. The Marvin tuner is of the so-called advancing nut type, of which many hundred thousands have been sold in the automobile industry by General Motors and others [R. 368-371]. Again there is the switch type tuner of the Chrysler line which has found considerable commercial usage, as testified to by plaintiff's witness Schwarz [R. 333]. It is not submitted by plaintiff that these tuners, all satisfactory, accurate, and easily settable, antedated the patent with the exception of the Zenith tuner and the Schaefer and Marvin patents, but it is clear that defendant's alleged invention was not basic and indispensable to the tuner industry, it being only applicable to the Marschalk or adjustable tappet-rocker-lever type.

Therefore, contrary to the assertions of appellant, the record establishes that rather than showing wide experimentation demonstrating a need for his asserted solution, the experimentation inferred from the evidence was not directed to the narrow problem allegedly posed by the Marschalk structure, which problem could not have been present prior to 1937, but rather, concerned entirely different type tuners. No evidence whatsoever establishes either that the art prior to appellant needed his alleged invention, that any problem existed requiring his alleged invention, or that anyone preceding appellant engaged in any unsuccessful attempts to reach the alleged invention.

But even assuming contrary to the record that a problem did exist when appellant entered the field, the evidence further shows that the structure devised by appellant was appallingly impractical, superseded no prior devices, and met with no commercial success whatsoever. This structure, as it appears in the reissue patent in suit, consists in an operating lever, freely adjustable tappets pivoted thereon, a locking lever for said tappets, and two

rotatable rockers engageable by the tappets to tune simultaneously a combination radio and television set. This Court may view a model of the patented structure prepared by appellee's witness Schwarz [Pltf. Ex. 5, R. 383]. Simple inspection of such model and of appellant's patent disclosure makes it evident that this so-called invention is indeed but a poor answer to the problem, if one existed, posed by Marschalk. Schwarz, operating the structure before the court as taught in the patent in suit, demonstrated that it was totally impractical and unworkable. He set the tappets as taught in the patent in suit, locked the tappets and then proceeded to see if pressing the lever would turn the rockers and thus the condensers to their initially set position in order to bring in the stations. Neither rocker returned to its proper position, and Schwarz explains that such failure was due to the high step-up in the structure and to its ineffective lock-up design, and that the mechanism would not be commercially satisfactory. Schwarz further testified that in order to attempt to make the patented structure workable, either a larger diameter locking hub would have to be used than was shown in the patent, resulting in limiting the angular movement in the tuner, or a long lever would have to be used, resulting in an extremely large tuner. He also testified that the situation might be improved by increasing the brake coefficient of friction, but he was not sure what kind of result would be gained by this. In view of Schwarz' previous testimony that the total angular movement in the two rockers of the reissue patent in suit was 25 degrees and 38 degrees, respectively, and that this was not near optimum in efficiency, further decrease of the permissible turning angle in the model as would be required by an increase in the lock size would even more reduce the efficiency of the

device [R. 376-381]. The tuner, therefore, is inherently impractical.

It thus appears that the actual structure devised by appellant is commercially unusable. That such is the fact is amply demonstrated by the record of its so-called impact upon the industry. The record of the impact of appellant's alleged invention upon the industry is that never was such a tuner built or sold commercially, even by appellant's licensee. Appellant's own testimony shows, first, that no commercial device was ever built showing the double tappet-rocker system for simultaneously tuning radio and television sets and, second, that no commercial device was ever built including his lever operated tuner with or without his television tuning means [R. 279, 280].

Each and every tuner referred to by appellant as establishing the superseding by his invention of that which had gone before is admittedly a leverless, push button tuner of the type expressly held not to be covered by the patent in suit by this Court in *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, and in *Leishman v. Radio Condenser Co., et al.*, 167 F. 2d 890. None of such tuners descends from appellant's alleged invention, but, on the contrary, the tuners are of the push button type, first placed upon the market by the Crosley Corporation in January, 1938, prior to the issuance of the reissue patent in suit or its original, patent No. 2,108,538 [Ex. 3 attached to complaint, R. 11, R. 217, 218].

In the Court below and in previous litigation, appellant urged that representatives of the Crosley Corporation had access to his disclosure of a coaxial tappet-rocker system when they designed the Crosley tuner, and that thus his

patent is responsible for all the subsequent tuners. This disclosure was supposed to have come about when appellant's patent No. 2,084,851 [Pltf. Ex. O, R. 843] issued, and its file wrapper containing the drawings in the patent in suit became publicly available. The contention was rejected by Judge Harrison in the original case of *Leishman v. Associated Wholesale Electric Co., supra*, and was rejected by Judge McCormick below, who expressly found, first, that the widespread acceptance of the afore-said push button tuners in the radio industry was not attributable to the disclosures of the patent in suit, and who, secondly, found that such widespread acceptance of push button tuners appears to be due to independent research and experiments by Crosley [Findings of Fact Nos. 11 and 12, R 53]. Appellant has apparently abandoned this contention but still bluntly states in his brief that "There is no evidence that anyone else came upon appellant's solution at about the same time, either before or after" (App. Op. Br. p. 82). This statement is untrue, as evidenced by the testimony before Judge Harrison in the *Associated Case, supra*, which testimony is present in this record by stipulation [R. 480-529], and which testimony supports the findings of Judge McCormick. It is, of course, also untrue in view of the Schaefer and Cunningham patents.

All the commercial success that can be urged for the patent in suit is that appellant licensed the Crowe Name-Plate and Manufacturing Company under his patent No. 2,084,851 [R. 277], that later Crowe included in the license agreement the original of the patent in suit, and that Crowe through Quality Hardware and Manufacturing Company manufactured and paid royalties to appellant on fifty thousand plunger type tuners until 1940 [R. 280, 281]. It should be carefully noted that this



minuscule portion of the tuner output in the industry consisted not of tuners representative of the disclosure of the patent in suit, but rather push button tuners not coming on the market until the summer of 1938 [R. 226], some months after the advent of the Crosley tuner and being substantially the same as was the Crosley tuner [R. 644, 645]. Since, therefore, none of the tuners upon which appellant relies for a showing of commercial success bears any identity with his patent, it is unnecessary herein to review the law with respect to the effect of commercial success on the issue of invention. The rule is well established that for commercial success to be material at all it must be by devices substantially identical to that shown and described in the patent in suit. It is not sufficient to point to the commercial success of independently developed different structures and contend that they include the invention of the patent in suit. *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 86 L. Ed. 58; *Schreyer v. Chicago Motocoil Corp.* (7 Cir., 1941), 118 F. 2d 852; *Johnson v. Lambert* (2 Cir., 1916), 234 Fed. 886; *Haggerty v. Rawlings Mfg. Co.* (8 Cir., 1926), 14 F. 2d 928.

The record, therefore, establishes that appellant has failed to show any long-felt need or want for his alleged invention, any series of unsuccessful experiments directed towards his alleged solution, and any superseding by his structure of that which has been used before. Appellant in failing to show a need for his invention merely shows an ingenious synthesizing of a problem in a patented structure which issued three years after appellant's own claimed invention. In failing to show any experimentation seeking to solve this problem, appellant merely establishes work of diverse nature directed towards the devising of tuners having nothing to do with the type of tuner to



which his alleged invention related; and in attempting to show commercial success for his alleged invention, appellant has merely shown that whereas none of his own tuners has ever been manufactured and sold, all commercial success in the field has gone to those push button type tuners originally designed by Crosley, which this Court has expressly excluded from the scope of appellant's patent.

(b) Long Prior to Appellant's Alleged Invention the Principle of Coaxiality Was Commonly Understood by Mechanics and Utilized as a Common Expedient for the Purpose of Avoiding Unbalanced Moment Arms in Machine Design.

It was upon this ground that Judge Harrison in *Leishman v. Associated Wholesale Electric Co.*, 36 F. Supp. 804, held the appellant's patent in suit invalid. The same arguments were presented to Judge Harrison and to this Court on appeal following his decision as are here presented by appellant, and Judge Harrison, as did Judge McCormick below, reached the conclusion that appellant's alleged coaxiality did not involve the exercise of the inventive faculty. Despite appellant's contention that the presumption of validity of his patent was restored when this Court found his patent not infringed in the *Associated Case* appeal, Judge Harrison's decision has not been overruled, this Court having expressly and with care refused to decide on validity at all, stating in its opinion (137 F. 2d 722, 727):

"Since the claims, if valid, are not infringed, the question of their validity need not be decided. The judgment declares that the claims are 'invalid for want of invention.' In the view we take, the declaration is unnecessary. As to its correctness or incorrectness, we express no opinion."

Appellant urges in his brief that Judge Harrison misunderstood the nature of coaxiality and urges that this Court disagree with Judge Harrison. That Judge Harrison did not misunderstand the nature of coaxiality and that his decision was correct when written and is still correct is shown by the fact that the same conclusion was reached by the Court of Appeals for the Tenth Circuit in *Richards & Conover Company v. Leishman*, 172 F. 2d 365, and by Judge McCormick below. The record before Judge Harrison, and the record before the Court of Appeals for the Tenth Circuit are neither more favorable nor less favorable to appellant than is the record here. The differences, if any, are in presentation and in argument, and the three records compel the conclusion that appellant's so-called coaxiality is but a symmetrical lining up of axes in order to reduce undesirable moment arms, *i. e.*, the common mechanical expedient of concentricity.

As to this, appellant's own expert in the *Associated Case* testified, which testimony is set forth in Judge Harrison's opinion:

“Q. Whenever you have two members that you want to turn together in the same orbit or to maintain contact with each other as they are turning together, you know that they should be on-center, isn't that correct? A. Well, they may be coacting in such a way that the resultant would be a center.

Q. The resultant; either they are actually on-center or the resultant amounts to the same thing; isn't that correct? A. Yes; so they will function together.

Q. In other words, this matter of putting these members on-center is one of the common tools and one of the common experiences of a machine designer? A. Yes. If you have reference to machine elements in a machine; yes.' ” (Pp. 808-809.)

That this was a common mechanical expedient was appreciated by Judge Harrison, and it will be understood that in all the structures of the instant case, the incorporation of coaxiality merely means that the devices are balanced and that no moment arms exist which during setting are likely to push the rocker of appellant or Cunningham or the rack and pinion of Schaefer to a detuned position.

The witness Schwarz testified on this point that in the General Motors tuners the centers of the tappets are so arranged that they are symmetrical or concentric or identical with the centers of the rocker and that such is coaxiality [R. 340]. He further testified that the principle of coaxiality is understood by machine designers, that it is a mere application of a principle of engineering amounting to the elimination of all moment arms, and that such principle was known to engineers from the time of his schooling [R. 341]. Furthermore, he testified that the elimination of moments by making things line up concentrically or coaxially is a well-known and well-established principle of engineering [R. 341-342].

The witness Schwarz explained on his redirect examination just exactly what he meant by the principle of moment arm elimination in these coaxial tuners, and he stated:

“A. I will endeavor to do so. If the two centers are at a distance from each other the separating distance is considered the lever arm or a moment arm.

When one point of one circle hits the point of its mating circle and the centers are not together—in other words, there is a moment arm difference between centers, then there will be a fight between the two circles as to each one wanting to follow its own path because of the leverage which exists between those two points.

I don't know whether that makes it entirely clear. Let me see if I can elucidate. For example, if we were striking right through the center of a circle with an arm and hitting the exact center of that circle the circle would not be expected to turn because there would be no moment arm, but if we were striking with an arm any point out from that center we would have a moment arm by the distance out from that center and the circle would then move such as a crank and the crank would be the moment arm.

Q. Now, what is the relation between this matter of moments which you have just described and the principle of concentricity or symmetry which you referred to on your direct examination?

\* \* \* \* \*

Q. By Mr. Lyon: Mr. Schwarz, what does this engineering practice of eliminating moments, that technique, have to do with the fact that in this tuner having an adjustable tappet and a rocker with coaxiality there is no walking movement of the operating member as demonstrated to the court here?

A. This application of the old principle of moment arms and how they work and how they function would be in this case to prevent the tappet from jumping around, or, in other words, from moving when it came into relation with the rocker. And that, as I have tried to point out, is application of an old principle to produce a desired result, because without a moment

arm the two pieces would either not move, or if actuated would move together.

Q. If the moments were eliminated would their effect be as you have stated, if two members move that they move together, or if one moves the other will move with it?

A. I think one is the converse of the other. In other words, if we consider one a transmitting means, and the other a receiving means, if the one was actually in dynamic movement the other would be expected to move with it if they were concentric. But if the one was not in movement and the other came up against it, it would not be considered to move in any other plane or in any other circle, because of the elimination of moment arms. I think I can explain by a simple example, if I may be permitted to do so, to try to make my explanation a little clearer: If a toolmaker, as I said before, had to drill a hole or prick-punch a bar, he would put it in a 'V' block and would be sure to punch it in the dead center of that bar, otherwise the bar would move relative to the V block, and that would be the application of moment arms to movement, if he punched or drilled it in the dead center it would not be expected to move.

Q. Does a toolmaker practice that technique of eliminating moments in the ordinary course of practicing his profession?

A. Yes, he does, when he takes a bar and puts it in a drill press, or if he wants to prick-punch it to drill it he puts it in the V block and then hits or drills it in the dead center right through the center of the bar, and thereby introduces no upsetting moment arms causing no movement of the one relative to the other.

Q. To make the record clear, is it your testimony that this technique of eliminating moments in design-



ing machines or pieces of apparatus is what you referred to as principles of symmetry or concentricity, which you stated were known and expected of machine designers, to your knowledge, ever since you have been in school?

A. That is what I meant when I testified to the symmetry, concentricity and coaxiality, and the laws of it for relative movement or non-movement." [R. 438-441.]

Appellant in his opening brief attempts to make much mystery of the alleged setting difficulty which he synthesized from the Marschalk patent disclosure. As recognized by Judge Harrison, as recognized by the Court of Appeals for the Tenth Circuit, as recognized by Judge McCormick, and as demonstrated by the witness Schwarz, no such mystery exists. The setting difficulty in the model constructed by appellant [Deft. Ex. E] is but an example of unbalanced moment arms, and coaxiality is but a common expedient for avoiding such unbalanced moment arms. As the above testimony shows, the centers of the tappet and of the rocker are made concentric, so that there will not be a force directed on one side of the axis of the rocker when the freely pivoted tappet is brought into engagement therewith. The presence of such a force, *i. e.*, a moment arm, would tend to detune the rocker during setting. Absence of that force or moment arm would mean that the force was being directed through the center of the rocker and thus not tending to turn the same. Mr. Schwarz makes this perfectly clear in his analogy respecting prick-punching a bar. As with appellant's structure, as with the prior Schaefer structure, and as with the prior Cunningham structure, the tool maker directs his force precisely through the center of the piece, as hitting other-

wise the force would pass to one side of such center, operate as a moment arm and turn the piece. It is merely the application of a common principle. It is present in Schaefer as heretofore explained and as evident from the fact that Schaefer no more detunes during setting than does any other coaxial structure. It is present in Cunningham. It was understood by the Crosley designers when they independently devised the Crosley tuner from which all the present tappet-rocker tuners were developed. It is as simple as the common child's teetertotter which teeters because an unbalanced force is being applied to one side of its pivot point or center, and, as found by Judge McCormick, the application of this principle to radio tuning devices, were appellant the first to so do, would be nothing more than a new use *per se* [Finding of Fact No. 16, R. 54].

Appellant's principal argument used in the instant case, whereby he endeavors to show that he has invented, lies in his contention that he is the first to use coaxiality between two members to prevent them from rotating. The foregoing makes it obvious that appellant does not "prevent" rotation between rocker and tappet. He merely, by use of the principle of moment arm elimination, directs the force of the tappet directly through the center of his rocker, thereby, as in the case of the prick-punch operation, avoiding a moment arm which would tend during setting to cause his rocker to rotate or detune, or cause the bar of Mr. Schwarz' illustration to rotate within its "V" block support. Appellant's argument, expressed in the appendix to his brief, that the Court of Appeals for the Tenth Circuit, that an expert witness in the case in the Tenth Circuit, that Mr. Schwarz, and that appellee's counsel advanced incompatible theories explaining the foregoing

is unsound in the light of the foregoing analysis. However phrased and however illustrated, any explanation of this common phenomenon reduces to the simple proposition that coaxiality in the instant case, as it has always done before, merely balances out unwanted moment arms. Appellant produced for Judge McCormick no evidence that had not been before the Court of Appeals for the Tenth Circuit and before Judge Harrison, and Judge McCormick came to their same conclusion. Not only is Judge McCormick's finding of fact that the patent in suit is lacking in invention supported by substantial evidence in the record, but such finding is manifestly correct and properly in accord with the earlier decisions.

(c) This Court Should Follow the Decision of the Court of Appeals for the Tenth Circuit in *Richards & Conover Co. v. Leishman*, 172 F. 2d 365.

The Court of Appeals for the Tenth Circuit held the patent in suit invalid for want of invention in *Richards & Conover Co. v. Leishman*, 172 F. 2d 365. Following that decision and after rehearing, the Court reaffirmed its former decision and filed an opinion analyzing the problem synthesized by appellant from Marschalk and showing how obvious would be the application of coaxiality to the Marschalk structure in order to solve such problem. Appellant argues, however, that this analysis is in error and urges affidavits presented below on a motion to amend findings and for a new trial in support of his contentions.

Appellee submits, first, that such affidavits are not properly part of the record-in-chief on this appeal and thus should not be considered in a treatment of the merits of the appeal, and, second, that even if such affidavits were to be considered the affidavits do not traverse the correctness of the said analysis.

Affidavits such as these should not be considered on the merits of an appeal inasmuch as such affidavits are only pertinent to a consideration of the particular motion which they purport to support. The affiants were not present at the trial and appellee had no opportunity to cross-examine said affiants either with regard to their qualifications or with regard to that to which they made affidavit. *The Baltimore and Potomac Railroad Company v. Church Trustees* (1875), 91 U. S. 127, 23 L. Ed. 260; *Campbell et al. v. Rankin* (1879), 98 U. S. 261, 25 L. Ed. 435; *Stewart v. Wyoming Cattle Rancho Co.* (1888), 128 U. S. 383, 32 L. Ed. 439. Whereas such affidavits may be properly considered by this Court in considering the denial of appellant's motions for a new trial and to amend the findings, the disposition of such motions was within the discretion of the Court below and no abuse of such discretion is here shown. *United States v. Socony-Vacuum Oil Co.* (1940), 310 U. S. 150, 84 L. Ed. 1129; *Brown v. New York Life Ins. Co.* (9 Cir., 1945), 152 F. 2d 246; *Thiel v. Southern Pac. Co.* (9 Cir., 1945), 149 F. 2d 783.

Even if the affidavits were to be considered by this Court on the merits of this appeal, such affidavits do not detract from the soundness of the conclusion reached by the Court of Appeals for the Tenth Circuit. The substance of the analysis supporting the conclusion is set forth in the opinion at pages 371 and 372, wherein the Court states:

“Since the more the rocker is tilted the greater becomes the non-coaxiality between the axis of the rocker shafts and pin A and the greater becomes the tendency of the rocker to creep, and since, when the pin A approaches substantial coaxiality with the rocker shafts, creeping disappears, it is obvious that



the problem can be solved by effecting substantial coaxiality between pin A and the axis of the rocker shafts, when the tappet is in full engagement with the rocker.”

In view of the analysis and the proof by the drawings that when the rocker is tilted, unbalanced opposite lever arms exist which cause creeping, and that when substantial coaxiality is approached these unbalanced lever arms disappear, it is difficult to argue with the basic conclusion that invention is lacking in the instant patent. In view of the fact that the unbalanced lever arms to which the opinion refers are but unbalanced moment arms as shown by Schwarz, it is difficult to see how the conclusions of Schwarz can be controverted. The simple fact is that when the non-coaxial rocker and tappet are tilted, unbalanced moment arms exist which cause the resultant force applied by the tappet to be on one side of the rocker axis, and it is this force which causes creeping. The simple fact is that when substantial coaxiality is approached between rocker and tappet the unbalanced moment arms disappear, the force of the tappet is directed through the axis of the rocker, and creeping disappears.

Faced with this clear analysis of the Court of Appeals for the Tenth Circuit that a simple, well-known engineering principle was applied by appellant to the Marschalk device, appellant has attacked said analysis upon superficial and immaterial grounds, and by argument and through the affidavits hereinabove referred to has pointed to what he claims are inaccuracies in the drawings in the



opinion of the Court of Appeals for the Tenth Circuit. Appellant's argument and the substance of the affidavits constitute objections on two grounds: first, that the Court shows a structure in which the pin A and apex G are to one side of the line XY and appears to place reliance on this fact; and, second, that the distance of pin A from the edge of the tappet in Figure 2 is less than the distance of the pin A from the edge of the tappet in Figure 1. The first of these objections can be ignored, inasmuch as such objection is purely immaterial and has nothing to do with the correctness of the analysis or conclusion. Such analysis and conclusion do not require that the pin A or apex G be placed in any particular position with respect to the line XY. The second of the objections may likewise be ignored inasmuch as when the rocker is tilted as in Figure 1, the axis A and the axis D do indeed draw apart and the alleged error is thus no error at all, but merely exemplifies a diagrammatical approach to the problem.

It is fundamental law that in the absence of a showing of palpable error in the prior decision, a Court of Appeals will follow such decision where rendered by the Court of Appeals of another circuit. Comity and uniformity of justice require that this Court hold the patent in suit invalid for want of invention. *Beach v. Hobbs* (1 Cir., 1899), 92 F. 146; *Gormley & Jeffrey Tire Co. v. United States Agency, et al.* (2 Cir., 1910), 177 F. 691; *Cincinnati Butchers' Supply Co. v. Walker Bin Co.* (6 Cir., 1916), 230 F. 453; *Novadel-Agene Corporation v. Penn, et al.* (5 Cir., 1941), 119 F. 2d 764.

4. The Patent in Suit Is Invalid Since It Is for a Different Invention Than Was the Original Patent From Which It Was Reissued.

Judge McCormick withheld decision and made no findings respecting whether or not the claims in issue of the patent in suit could be sustained as being for the same invention as was appellant's original patent No. 2,108,538. The invalidity of such claims, however, on this ground is amply shown by the record in this case under the principles set forth by this Court in *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, and *Leishman v. Radio Condenser et al.*, 167 F. 2d 890.

Reissue of appellant's original patent No. 2,108,538 could, of course, only be made under the provisions of the reissue statute, *R. S. 4916, Title 35, U. S. C. Section 64*, which provides in part:

“Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. \* \* \*”

The basic requirement for a valid reissue patent under this statute is that the reissue patent must be “for the same invention.” This Court in the *Associated Case*, at page 723, stated:

“Thus a reissue patent must be for the same invention as the original patent. Otherwise it is invalid.” (Citing *U. S. Industrial Chemicals v. Carbide & Carbon Chemicals Corp.*, 315 U. S. 668, 675-681, 62 S. Ct. 839, 86 L. Ed. 1105.)

Courts have not hesitated to hold invalid reissue patents improvidently granted otherwise than for the same invention. *Parker & Whipple Co. v. Yale Clock Co.* (1887), 123 U. S. 87, 31 L. Ed. 100; *Lorraine, et al. v. Townsend et al.* (9 Cir., 1925), 8 F. 2d 673.

And the test for whether or not the reissue patent is for the same invention as was the original patent is whether or not that covered by the reissue patent was disclosed in the original and was intended to have been covered and secured by the original. The rule was set forth by this Court in the *Associated Case*, at page 723 of the opinion:

“An original patent and a reissue patent are not for the same invention unless what is covered by the reissue was disclosed in the original and was intended to have been covered and secured by the original.” (Citing again *U. S. Industrial Chemicals v. Carbide & Carbon Chemicals Corp.*, *supra.*)

This is the law in this Circuit and was the law prior to the *Associated Case*, it being stated in *Lorraine et al. v. Townsend et al.*, *supra*, at 675:

“In *Carpenter Straw Sewing Co. v. Searle* (C. C.) 52 F. 809, 814, Judge Coxe says: ‘Unless the court can find that the invention of the reissue is described as the invention in the original, and that the patentee *intended* to secure it as his invention in the original, the reissue is invalid; it is not for the same invention.’

“In *Corbin Cabinet Co. v. Eagle Lock Co.*, 150 U. S. 38, 42, 43, 14 S. Ct. 28, 30, 37 L. Ed. 989, the court says: ‘It is settled by the authorities that, to warrant new and broader claims in a reissue, such claims must not be merely suggested or indicated in the original specification, drawings, or models, but it must further appear from the original patent that they constitute parts or portions of the invention which were *intended* or sought to be covered or secured by such original patent.’” (Emphasis supplied.)

And in testing the reissue patent here in suit and the claims of said reissue patent here asserted by appellant, this Court further stated at page 723:

“\* \* \* Hence the questions here to be considered are whether what is covered by claims 7-11 of the reissue patent was disclosed in the original patent, and whether it appears from the face of the original that what is covered by claims 7-11 of the reissue was intended to have been covered and secured by the original.”

It is submitted by appellant that under the above principles appellant's reissue patent is invalid; first, because appellant persists in asserting a scope for his patent expressly stated to be an invalid scope by this Court in *Leishman v. Associated Wholesale Electric Co., supra*, and in *Leishman v. Radio Condenser Co., et al., supra*; and, second, because nowhere did original patent No. 2,108,538 show any intent to cover and secure as invention the coaxiality which appellant now asserts to be his contribution to this art.

- (a) Since Appellant Persists in Asserting for His Patent a Scope Held to Be Invalid by This Court in *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, and in *Leishman v. Radio Condenser Company, et al.*, 167 F. 2d 890, This Court Should Now Hold the Patent Invalid.

This Court in *Leishman v. Associated Wholesale Electric Co., supra*, held that plunger type tuners did not infringe the patent in suit, stating at page 727:

“These claims, it will be observed, are for combinations each of which includes a rocker. Whether the combinations include tappets and levers is not clear. If they do not include levers, the claims are not for the same invention as the original patent and hence are invalid. If they do include levers, the claims are not infringed, for the accused device contains no lever.”

Thus through a limitation of appellant's claims compelled by the reissue statute, this Court preserved the validity thereof. Appellant, however, has been unwilling to abide by the limitation. He again asserted the claims to cover plunger type devices before this Court in *Leish-*



*man v. Radio Condenser Co., et al., supra*, wherein the earlier decision in the *Associated Case* was reaffirmed, the question of validity not being before this Court. He asserted the claims to cover plunger type tuners in *Richards & Conover Co. v. Leishman*, 172 F. 2d 365, and the claims were held there invalid. He again asserts the claims to cover plunger type tuners in this litigation, Judge McCormick having held them invalid. It would appear that the generosity of this Court in saving the patent in suit for appellant, plus appellant's determination to ignore the decision of this Court, has resulted in years of expensive added litigation. It is submitted that such litigation should be terminated and that this Court, accepting the claimed scope upon which appellant insists, should now hold the patent an invalid reissue. Such a holding would be consistent with prior practice by this Court. *Dallas Machine & Locomotive Works, Inc. v. Willamette-Hyster Company, et al.* (9 Cir., 1940), 112 F. 2d 623.

Appellant in his brief does not expressly attempt to justify the reissue patent in suit as a valid reissue for the same invention as was original patent No. 2,108,538. However, in arguing the question of infringement, appellant urges, first, that this Court was in error in the *Associated Case, supra*, and second, that new evidence exists establishing equivalency between levers and plungers, and that, therefore, an intent to cover and secure as his invention plunger type tuners is evident in the original patent.

It would be idle here to review those considerations which led to the decision of this Court in the *Associated Case*. The question of the allowable scope of appellant's claims was reargued in the *Radio Condenser Case*, and there this Court expressly reaffirmed its decision respect-

ing this patent. Nothing in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, ..... U. S. ...., 94 L. Ed. Adv. Op. 767, cited by appellant, changes the law in this Circuit respecting the doctrine of equivalents or the principles underlying such doctrine either as applied to an original patent or as applied to a reissue patent. Nothing in appellant's arguments, which are but reiteration of that which has previously been argued before this Court, furnishes grounds for a departure by this Court from the principle of its previous decisions.

Appellant argues here, as he did in the *Radio Condenser Case*, that new evidence exists establishing plungers and levers as equivalents and that, therefore, his original patent evidenced an intent to cover plunger type tuners. In the *Radio Condenser Case*, such evidence consisted in patents allegedly not before this Court, showing plungers in radio tuners, and in a showing of various devices illustrating plungers and levers. Here the asserted new evidence consists of texts purporting to prove that the portion 57 of the lever F of appellant's original patent is a plunger, and charts illustrative of appellant's testimony from the stand, which testimony purported to show that as a matter of fact levers and plungers are equivalents.

As to the contention of appellant, assertedly supported by new evidence, that a plunger is shown in the drawings of his original patent, it should first be pointed out that the decisions of this Court in the *Associated* and *Radio Condenser Cases* were based upon what the face of the original patent showed to have been intended to be secured and covered as the invention. Even were a plunger shown in the drawings of the original patent, such showing would provide no evidence of intent to cover and secure plungers as the invention in the originally claimed com-

bination. No reference whatsoever was made in the objects, description, or claims of the original patent to plungers of any kind. Even had the term "plungers" been written into the original claims, such claims would have been unsupported by the disclosure. *Permutit Co. v. Graver Corp.* (1931), 284 U. S. 52, 76 L. Ed. 163. Absent the element plungers in the original claims, reference to the bare drawings will not justify a reading of the term into the claims. *Dugan v. Lear, Inc.* (2 Cir., 1946), 156 F. 2d 29. Much less does reference to said drawings evidence any intent to cover and secure plungers as the invention of the original patent. Finally, the alleged plunger portion of the said drawings is not in fact a plunger, but was rather referred to as, and is, an extension 57, part of the lever F [Deft. Ex. A, p. 1, Col. 2, lines 34-35].

Appellant's charts illustrative of his testimony to the effect that plungers and levers perform the same function are, of course, not new evidence, but are merely additions to argument presented to this Court before. This Court decided in the *Associated Case*, and reaffirmed its decision in the *Radio Condenser Case*, that plungers and levers did not perform the same function in the same way. Appellant here, as in the *Radio Condenser Case*, again urges, this time illustrating his argument by the said charts, that plungers and levers were used as equivalents prior to his alleged invention. Such fact is immaterial here where we are concerned with the question of equivalency in a particular shaft positioning structure. The very fact that

appellant in his testimony sought to minimize, that is, the traveling in an arcuate path by levers and in a straight path by plungers, is itself determinative of the issue of equivalency. It is this fact that constituted the difference between the effect on industry of appellant's patented tuner and the Crosby push button tuner. Appellant has admitted that not a single lever operated tuner, such as his patented tuner, has ever been manufactured and sold since the Zenith tuner, Defendant's Exhibit H, in 1930. Schwarz testified that one of the reasons the said Zenith tuner could not be used for automobiles and was abandoned in 1930 for household sets was its bulky nature due to the use of levers [R. 387]. This Zenith tuner embodies the showing of the Schaefer patent, and Judge McCormick found as a fact that such tuner failed of commercial success because of the bulkiness and unsightly appearance of the levers specified for such tuner [Finding of Fact No. 10, R. 52-53]. Crosley in the *Associated Case* testified that Crosley developed the push button tappet-rocker combination because the lever type was cumbersome [R. 537]. As is admitted by all parties, the Crosley tuner and the subsequently developed push button tuner have achieved overwhelming commercial success and, indeed, the Zenith tuner converted to a plunger type tuner as the General Motors tuner, Plaintiff's Exhibit 3, sold in the amount of 500,000 in 1939 and 1940 [R. 337].

Since, therefore, appellant insists in asserting an invalid scope for his patent, it is submitted that this Court should hold the patent void as an invalid reissue.



(b) Coaxiality Was Claimed in Defendant's Reissue Patent as an Afterthought and in Order to Cover After-Discovered Devices Not Falling Within the Scope of the Original Patent, and It Is Not the Same Invention Intended to Be Covered and Secured in Appellant's Original Patent.

Although this Court in dealing with the reissue patent in suit has not found it necessary to pass upon the point, in addition to the fact that the said reissue patent is invalid as failing to be for the same invention as was original patent No. 2,108,538 in respect to its failure to include levers as part of the claimed combination, said reissue patent is equally bad in that no vestige of intent appears upon the face of the original patent to cover or secure coaxiality as appellant's invention.

The parent application filed by appellant in 1934 [Deft. Ex. O, R. 843], from which original patent No. 2,108,538 was divided, but set forth the figures of the reissue patent in suit as Figures 14, 15 and 16 of such application, made no mention of coaxiality in the description of the application, and directed no claims therein to said coaxiality. When in 1937 appellant incorporated said Figures 14, 15 and 16 in the divisional application [Deft. Ex. P, R. 1001], which issued as original patent No. 2,108,538, he but alluded briefly in his description to the fact that the axes of the two tappets and two rockers therein described were coaxial and made no mention in the claims of coaxiality. When in 1938 the original patent issued, appellant had never written a claim to coaxiality, nothing was said about



coaxiality by description except for the aforementioned statement thereof, no statement of any problem requiring coaxiality was set forth in the description, no objects relating to coaxiality appeared therein, and no principle involving coaxiality was described. The original patent issued February 12, 1938. The independently designed coaxial Crosley tuner came on the market in January of that year, and it was not until appellant, after seeing the Crosley tuner and after having given notice of infringement under his original patent, and after having discussed the matter with the Crosley representatives [R. 299-300], on May 23, 1938, surrendered the original patent and made application for the reissue patent in suit, requesting for the first time claims which set forth coaxiality. Appellant had admittedly originally thought himself to be the inventor of the broad lever-tappet-rocker combination [R. 288], and it had never occurred to him to claim coaxiality as an actual invention. However, although he now denies it, he admitted in the *Associated Case* that he modified the claims of his original patent in the reissue so that they would cover the Crosley tuner [R. 300-302] and, in so doing, claimed coaxiality.

Whereas appellant now seeks to sustain claims 7 through 11, inclusive, of his reissue patent on the basis of the aforesaid coaxiality, reference to claims 1, 2, 3, 4 and 6 and, indeed, disclaimed claim 5 of his original patent, shows nothing on the subject of coaxiality. In the previous litigation, and below, appellant argued that claim 1

of the original patent evidenced an intent to claim coaxiality in stating:

“\* \* \* a plurality of adjustable members pivoted to said lever at a point substantially as far from the fulcrum of said lever as said axis is from said fulcrum, \* \* \*.”

This statement has nothing to do with coaxiality. In a double tappet, double rocker combination for both radio and television, such as was being claimed by appellant, this equidistant condition of rocker axis and tappet axis is necessary to assure that the two tappets will fully engage the two rockers. It does not define coaxiality which requires that the axes be not only equidistant from the fulcrum of the lever, but that the axes be aligned vertically when in contact. Appellant testified that he achieved his coaxiality by imparting a special shape to his tappet [R. 153, 154, 274, 275]. Yet, nowhere in the original patent claims or in the original description is a description of the shape of appellant's tappet set forth, let alone given a purpose or described in such a way as to give evidence of intent to secure coaxiality for his invention.

The record therefore establishes conclusively that no more can appellant now claim coaxiality for the invention of his reissue patent than can he claim that a leverless combination is covered by said reissue patent. Yet, since appellant bases his entire case of invention on such coaxiality and admittedly cannot sustain said reissue patent as an invention without coaxiality, said reissue patent must be held invalid under the statute as directed to a different invention than was original patent No. 2,108,538.

5. Even if This Court Holds the Patent in Suit Valid, It Should Follow Its Prior Decisions and Hold It Not Infringed by the Devices of Appellee.

The accused tuners in the instant case are represented by Plaintiff's Exhibits 6 and 7. Plaintiff's Exhibit 7 incorporates a rocker, a tappet and a plunger, the plunger pivotally carrying the tappet and sliding the same transversely to assume a coaxial position against the rocker. Plaintiff's Exhibit 6 includes a rocker, a tappet and a slidable plunger, but the plunger does not pivotally carry the tappet but rather supports an arcuate guideway, which in turn slidably supports the tappet. Such tuner, Plaintiff's Exhibit 6, therefore, is the same as Plaintiff's Exhibit 7, except that instead of providing an opening in the rocker which receives a portion of the tappet, it provides an opening in the tappet which receives a portion of the rocker. Both tuners are patentwise the same and neither includes a lever.

This Court in *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, held that the Crosley tuner [Ex. 3 attached to complaint, R. 11], was not an infringement of the patent in suit because such tuner included plungers rather than levers. Such tuner is admittedly patentwise the same as the accused tuners in suit. This Court likewise held in *Leishman v. Radio Condenser Co., et al.*, 167 F. 2d 890, that the Radio Condenser tuners and the General Instrument tuners [Exs. 4 and 5 attached to the complaint, R. 12 and 13] were not infringements of the patent in suit because such tuners included plungers rather than levers.

Judge McCormick below made no express holding with respect to infringement but did indicate that, if necessary, under his decision he would have held that the accused

tuners do not infringe the patent in suit. This, of course, was compulsory on the part of Judge McCormick in view of the *Associated Case*, and in view of the *Radio Condenser Case*, the latter case having expressly set forth the duty of the court below to follow the decision of this Court in the *Associated Case*.

Appellee has shown hereinbefore whereby appellant's argument attacking the decision in the *Associated Case* is but reiteration. Appellee has shown hereinbefore that appellant's asserted new evidence respecting the drawings of the reissue patent is immaterial. Appellee has shown hereinbefore that the various charts and the like illustrating appellant's repetition of his old argument that plungers and levers are equivalents are not new evidence.

It is submitted that this Court should not overrule its two prior decisions in the absence of the most compelling reasons. Since the decision in the *Associated Case* by this Court in 1943, manufacturers of plunger type tuners have relied on that decision and have produced and sold plunger type tuners accordingly. Such reliance was proved justified when this Court reaffirmed its decision in the *Radio Condenser Case*. Uniformity of justice requires that in the event it becomes necessary to decide the question of infringement in this case this Court hold that the aforesaid plunger type tuners, including those of appellee, do not infringe the patent in suit.

Respectfully submitted,

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